



#*li*  
1/29/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: MAYUMI=1

In re Application of:	)	Art Unit: 1632
	)	
Tadanori MAYUMI et al	)	Examiner: L. Chen
	)	
Appln. No.: 10/070,252	)	Washington, D.C.
Nationalized: July 8, 2002	)	
	)	
I.A. No: PCT/JP00/01267	)	
I.A. Date: March 3, 2000	)	Confirmation No. 9722
	)	
For: METHOD AND FORMULATION FOR	)	January 27, 2003
SUSTAINED INTRACELLULAR...	)	

REPLY TO ELECTION REQUIREMENT

**RECEIVED**

JAN 28 2003

Honorable Commissioner for Patents  
Washington, D.C. 20231

**TECH CENTER 1600/2900**

Sir:

The applicants are in receipt of Paper No. 7, an Office Action mailed December 27, 2002, entirely in the nature of an election requirement.

The present application is the U.S. national phase of a PCT application, and the applicants have claimed priority from their corresponding application filed in Japan on September 3, 1999. Also, the PCT branch of the PTO has acknowledged receipt of the priority document in the communication mailed May 8, 2002. Accordingly, applicants

request the PTO to acknowledge receipt of applicants' papers filed under §119.

The PTO has in effect required an election among three (3) subgenera, and has stated that the claims lack unity of invention. As the applicants must make an election, even though the requirement is traversed, applicants hereby respectfully and provisionally elect subgenus (3) directed to "genes", with traverse and without prejudice.

While the Office Action acknowledges that normal U.S. practice does not apply, i.e. unity-of-invention Rules under PCT apply, the Office Action nevertheless seems to be based on U.S. practice rather than PCT practice. Applicants claims are generic and therefore at least claims 1-3 define the same or corresponding special technical feature which extends through all three sub-genera. There is unity of invention under PCT Rules 13.1 and 13.2, and the requirement should be withdrawn.

Such unity-of-invention is fully consistent with what occurred during the international phase where all five original claims were examined, were found to possess novelty, inventive step and industrial applicability, with no holding of lack of unity of invention. The PTO is obligated by international treaty to follow the PCT rules, and therefore

this is another reason the requirement should be withdrawn,  
whereby all the claims should be examined.


Applicants respectfully request withdrawal of the  
requirement and examination of all the claims on the merits.

Applicants now respectfully await the results of a  
first examination on the merits.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.  
Attorneys for Applicants

By

  
Sheridan Neimark  
Registration No. 20,520

SN:jaa

Telephone No.: (202) 628-5197

Facsimile No.: (202) 737-3528

G:\BN\Y\YUAS\Mayumil\PTO\Election Reply JA03.doc

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Tadanori MAYUMI et al

Application No.: 10/070,252

Filed: July 8, 2002

For: METHOD AND FORMULATION FOR SUSTAINED INTRACELLULAR...

Confirmation No.: 9722

Art Unit: 1632

Examiner: L. Chen

Washington, D.C.

Atty.'s Docket: MAYUMI=1

Date: January 27, 2003

THE COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

Sir:

Transmitted herewith is a ☒ REPLY TO ELECTION REQUIREMENT in the above-identified application.☐ Small entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement.☐ A verified statement to establish small entity status under 37 CFR 1.9 and 1.27 is enclosed.☒ No additional fee is required.

The fee has been calculated as shown below:

	(Col. 1)		(Col. 2)	(Col. 3)
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA EQUALS
TOTAL	*	MINUS	** 20	0
INDEP.	*	MINUS	*** 3	0
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM				

SMALL ENTITY	
RATE	ADDITIONAL FEE
x 9	\$
x 42	\$
+ 140	\$
ADDITIONAL FEE TOTAL	
	\$

OTHER THAN SMALL ENTITY	
RATE	ADDITIONAL FEE
x 18	\$
x 84	\$
+ 280	\$
TOTAL	
	\$

\* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

\*\* If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.

\*\*\* If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

☒ Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

☐ It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

## Small Entity

## Response Filed Within

- ☐ First - \$ 55.00  
☐ Second - \$ 205.00  
☐ Third - \$ 465.00  
☐ Fourth - \$ 725.00

## Month After Time Period Set

## Other Than Small Entity

## Response Filed Within

- ☐ First - \$ 110.00  
☐ Second - \$ 410.00  
☐ Third - \$ 930.00  
☐ Fourth - \$ 1450.00

## Month After Time Period Set

☐ Less fees (\$ ) already paid for \_\_\_ month(s) extension of time on \_\_\_\_\_.☐ Please charge my Deposit Account No. 02-4035 in the amount of \$ \_\_\_\_\_.☐ Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of \$ \_\_\_\_\_.☐ A check in the amount of \$ \_\_\_\_\_ is attached (check no. ).

☒ The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR \$1.16 and all patent processing fees under 37 CFR \$1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR \$1.18.

BROWDY AND NEIMARK

Attorneys for Applicant(s)

By:   
 Sheridan Neimark  
 Registration No. 20,520

Facsimile: (202) 737-3528  
 Telephone: (202) 628-5197

RECEIVED  
 JAN 28 2003  
 TECH CENTER 1600/2900